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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,356	07/07/2003	Mark Schwieg		7905

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Mark Schwieg
900 OLD PEACH TREE RD
LAWRENCEVILLE, GA 30043

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/614,356

Applicant(s)

SCHWIEG ET AL.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) 6-8 and 10 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 and 9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Type of Securing Mechanism

- a. Species 1 (bolt/screw): Claim 6.
- b. Species 2 (angled groove inside of cavity): Claim 7.
- c. Species 3 (angled groove on outside of cap): Claim 8.
- d. Species 4 (threads on cap and cavity): Claim 9.
- e. Species 5 (tabs): Claim 10.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-5 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Mark Schwieg on 13 July 2004 a provisional election was made without traverse to prosecute the invention of species 4, claim 9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-8 and 10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.

Specification

3. The disclosure is objected to because of the following informalities: On page 4 lines 14-15 the weight element is referred to as reference number 17 and the interface element is referred to as reference number 18. From the drawings and the rest of the specification it appears that in these two lines the reference numbers are reversed.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-5 recite the limitation "said body" in line 1. Also claims 6-10 recite the limitation "said method" in line There is insufficient antecedent basis for these limitations in the claims since there was no previous body or method said. It is uncertain what body or method is being referred to.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Owen.

Owen discloses an interface element in the form of a metal sleeve (Ref. No. 12, Col. 2, Lns. 1-8) mountable to a sporting equipment handle in the form of a baseball bat (Title), a metal weighting element/body being mountable to an interface element and made of subassemblies stacked together (Ref. No. 15, Col. 2, Lns. 49-53, Fig. 2), a securing mechanism for holding the weighting element to the interface element in the form of a retainer (Ref. No. 19, Fig. 6), and a securing mechanism using threads on outside of a cap and along an inside of a cavity wall (Fig. 2).

8. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsu. Hsu discloses an interface element in the form of an end cap (Ref. No. 22, Fig. 6) and a flexible frame (Ref. No. 24, Fig. 6) mountable to a sporting equipment handle in the form of a racket (Title), a weighting element (Ref. No. 25, Fig. 4, Col. 2, Lns. 40-44) being mountable to an interface element (Fig. 6), a securing mechanism for holding the weighting element to the interface element in the form of the process of using a positioning flange (Ref. No. 241, Fig. 6, Col. 2, Lns. 36-39), and an interface element/body having a cavity at one end in the form of a recess at the end of the end cap (Fig. 6) and on an opposite end a sleeve that fits over a racquet (Fig. 6).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huiskamp.

Huiskamp discloses an interface element in the form of a plastic sleeve (Fig. 1, Ref. E, Col. 2, Lns. 47-60) mountable to a sporting equipment handle in the form of a golf club (Title), a metal weighting element/body (W, Col. 7, Lns. 7-19) being mountable to an interface element (Col. 4, Lns. 57-67, Fig. 2), an interface element being a plastic (Col. 2, Lns. 48-50) and affixing a weighting element to an interface element (Col. 4, Lns. 57-67).

Huiskamp lacks a securing mechanism for holding the weighting element to the interface element. Okoneski discloses a securing mechanism in the form of a process of using adhesive (Abstract) for holding a weight to shaft. In view of the patent of Okoneski it would have been obvious to modify the club of Huiskamp to have a securing mechanism of adhesive to affix a weight to an extension in order to utilize known affixing method used in the art.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone

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number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 16 July 2004



STEPHEN BLAU
PRIMARY EXAMINER